

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GURPREET S. AHLUWALIA
and DOUGLAS SHANDER

Appeal No. 1997-1717
Application No. 08/068,256

ON BRIEF

Before WINTERS, ROBINSON, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 8 through 12. Claim 2 stands objected to and "would be allowable if rewritten in independent form" (final rejection, Paper No. 13, page 2). Claims 3 through 7, the only other claims pending in the application, have been withdrawn from further consideration under 37 CFR § 1.142(b) as not readable on the elected claims.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

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1. A process of reducing mammalian hair growth, comprising
selecting an area of skin from which reduced hair growth is desired, and
applying to said area of skin a composition including an inhibitor of 5-
lipoxygenase in an amount effective to reduce hair growth.

The references relied on by the examiner are:

Shander (Shander I)	4,720,489	Jan. 19, 1988
Breuer et al. (Breuer)	4,885,289	Dec. 5, 1989
Shander et al. (Shander II)	5,132,293	Jul. 21, 1992

Ground of Rejection

Claims 1 and 8 through 12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Breuer, Shander I and Shander II.¹

We reverse the examiner's rejection. In addition, we remand this application to the examiner for consideration of U.S. Patent No. 5,928,654, brought to our attention in a communication filed June 9, 2000 (Paper No. 29). We also remand so that the examiner may consider this application in tandem with Application No. 08/068,257.

¹ The examiner withdrew the final rejection of claims 1 and 8 through 12 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure (examiner's answer, page 2, § (4)).

Background

The present invention is directed to a process of reducing mammalian hair growth by applying to the skin a composition including an inhibitor of 5-lipoxygenase (specification, page 1, lines 12-15). Appellants state that they “conceived that inhibiting the enzyme 5-lipoxygenase would reduce the rate of hair growth” (appeal brief, page 3). According to appellants, “[e]very inhibitor of 5-lipoxygenase that applicants tested caused a reduction in hair growth.” (Id.)

Discussion

I. Rejection under 35 U.S.C. § 103

All of the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Breuer, Shander I and Shander II. After careful consideration of the record, we will not sustain this rejection.

The examiner argues that all three references “disclose a number of structures which are useful in inhibiting hair growth” (examiner’s answer, page 4). According to the examiner, “[w]hile none of the compounds of the prior art are identified as 5-lipoxygenase inhibitors they would render the instantly claimed process obvious if they possessed any such activity” (Id.) (emphasis added). The examiner places the burden on appellants to show that the prior art compounds are “completely inactive” as 5-lipoxygenase inhibitors (Id.). We disagree with this line of reasoning.

As stated in In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977), quoting from In re Swinehart, 439 F.2d 210, 212-33, 169 USPQ 226, 229 (CCPA 1971):

[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This burden was involved in In re Ludtke, 441 F.2d 660, 169 USPQ 563 (CCPA 1971), and is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics. In re Best, 562 F.2d at 1255, 195 USPQ at 433. On the particular facts of this case, however, the examiner has not shown sound basis for believing that the prior art compounds possess 5-lipoxygenase inhibiting activity. Unlike the situation presented in Best, the examiner has not set forth “reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter [5-lipoxygenase inhibiting activity] may, in fact, be an inherent characteristic of the prior art.” Accordingly, the examiner is not in position to invoke the above-quoted rule of law enunciated in Best and cases cited therein.

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The examiner's position is speculative in nature; it is devoid of factual support or adequate reasoning. Simply stated, it is not enough to speculate that the prior art compounds may possess 5-lipoxygenase inhibiting activity and, based on speculation alone, shift the burden of persuasion to appellants to establish that these compounds are "completely inactive" as 5-lipoxygenase inhibitors. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). On this record, the examiner cannot require appellants "to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on."

Having found that the examiner has not established a prima facie case of obviousness of the appealed claims, we find it unnecessary to discuss the declaration of Dr. Ahluwalia submitted on July 14, 1995 (attachment to Paper No. 11) and relied on by appellants to rebut any such prima facie case.

The examiner's rejection of claims 1 and 8 through 12 under 35 U.S.C. § 103 is reversed.

II. Remand to Consider U.S. Patent No. 5,928,654

On June 9, 2000, appellants filed a communication identifying a number of references that should be brought to the examiner's attention (Paper No. 29).

U.S. Patent No. 5,928,654 to Duranton (Duranton) is cited among those references. This patent is directed to the conjoint use of a lipoxygenase inhibitor and a cyclooxygenase inhibitor in a process for reducing hair growth (see Duranton, claim 1). The claims under appeal, written in open language, would appear to "read on" the subject matter set forth in the claims of Duranton. In addition, Duranton appears to disclose a number of appellants' preferred lipoxygenase inhibitors (Duranton, col. 4, lines 26-32, 51-59).

We note that Duranton was filed on April 14, 1997, almost four years after the filing date of this application. Thus, Duranton is not prior art against appellants. Appellants argue that the claims in Duranton were not rejected on the grounds advanced against their claims. Appellants argue, therefore, that there has been an apparent inconsistency in the way applications drawn to similar subject matter have been prosecuted.

In light of our reversal of the rejection of claims 1 and 8 through 12 under 35 U.S.C. § 103, and in light of the issuance of U.S. Patent No. 5,928,654, we remand this application to the examiner so that he may compare the two sets of claims and take further action as deemed appropriate. A copy of U.S. Patent No. 5,928,654 is enclosed with the opinion.

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III. Recommendation to Consider Related Application No. 08/068,257

Appellants invite attention to a related appeal in Application No. 08/068,257, involving the enzyme cyclooxygenase (appeal brief, paragraph bridging pages 2-3). Appellants state that the issues in both appeals are “substantially the same” (appeal brief, page 1). According to PTO records, Application No. 08/068,257 is currently awaiting action by the examiner.

In view of appellants’ statements, we remand this application to the examiner so that it may be considered in tandem with Application No. 08/068,257. We recommend that the examiner consider the relationship of the claims in this application to the claims

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in Application No. 08/068,257, and in Duranton, for further action as deemed appropriate.

REVERSED and REMANDED

Sherman D. Winters
Administrative Patent Judge

Douglas W. Robinson
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

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